

Application Serial No. 09/535,076  
Response to First Office Action  
Attorney Docket No. 0103490-165104  
Page 7

## REMARKS

### The Objection to the Specification

The amendments to the Abstract have reduced it to less than 150 words in length.

### The Rejections Under 35 U.S.C. § 102(b)

Claims 1-3 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Larson*. Applicant respectfully traverses, noting that *Larson* does not disclose all elements of claims 1-3.

#### Claim 1

First, Examiner admits that *Larson* does not disclose all elements of claim 1 when he states that *Larson* is "silent on apparatus associated with a cart is returned to a cart corral, customer identification signals which are manually entered wirelessly and a customer reward program" (Office Action, page 4). Thus, *Larson* cannot disclose limitations such as a customer identification "for a customer rewards program."

Second, *Larson* does not disclose the associating of a returned cart with a particular customer. *Larson* discloses an apparatus for dispensing discount coupons, *but these coupons are not associated with a particular customer – once printed, anyone can use them.*

In the system of *Larson*, users can obtain a cart 20 from a corral 15. At the end of the corral 15 is a monitor 19 and printer 24. The user chooses a desired coupon on the monitor 19, and the printer 24 prints a coupon 23 with a serial number for authentication. When the coupon 23 is redeemed, the serial number is checked for authenticity, and a key 22 is printed. When the cart 20 is returned to the corral 15, the key 22 is scanned in and authenticated, allowing the user to choose another coupon 23 or a chance for instant cash. This provides incentive to return carts.

Both the coupons 23 and the key 22 have authentication numbers for validation, but these numbers simply indicate whether the coupon 23/key 22 is valid, or a forgery (*E.g.*, Col. 7:30-34). *They are not associated with a particular customer identification number.* Nowhere does *Larson*

Application Serial No. 09/535,076  
Response to First Office Action  
Attorney Docket No. 0103490-165104  
Page 8

require any customer identification, or generate any customer ID numbers. Thus, anyone can use the coupon 23 or key 22, even if they were not the ones to borrow/return the cart.

In contrast, claim 1 discloses associating "the returned cart with a particular customer for a customer reward program." Unlike *Larson*, rewards are given only to the person returning the cart. This offers advantages over systems like *Larson*'s. For example, such a system allows stores to give customers rewards based on how many times that particular customer has returned a cart (Specification, page 20, lines 16-24), something that would be impossible to do with the system of *Larson*.

### Claim 2

As above, *Larson* does not disclose the associating of a returned cart with a customer identification or customer identification signal. Also, Examiner further notes that "*Larson* is silent on a second interface which receives a second set of customer identification signals from the customer" (Office Action, Page 8). Accordingly, *Larson* does not disclose all elements of claim 2.

### Claim 3

Claim 3 depends from claim 2 and, as such, is patentable over *Larson* for at least the reasons described above.

### The Rejections Under 35 U.S.C. § 103(a)

Applicant respectfully traverses, noting that none of *Larson*, *Pare*, or *Buckens* discloses all elements of claims 1-16. More specifically, none of *Larson*, *Pare*, or *Buckens* discloses the associating of a returned cart with a customer.

Application Serial No. 09/535,076  
Response to First Office Action  
Attorney Docket No. 0103490-165104  
Page 9

Larson

As discussed above, *Larson* does not disclose the associating of a returned cart with a particular customer.

Pare

*Pare* discloses a tokenless biometric ATM access system. Users access the ATM through a biometric scanner 13, which verifies a person's identity (Col. 5:20-29). However, while the system of *Pare* may biometrically screen people for ATM access, it does not associate a returned shopping cart with a particular customer. As such, *Pare* does not disclose all elements of the claims as amended.

Buckens

*Buckens* discloses a theft detection system for detecting targets in an interrogation zone. Antenna panels 20, 22 are placed so as to scan shopping carts 18 that pass between them (Col. 4:53-57). Items of interest have magnetic targets 30 placed on them. The antenna panels 20, 22 generate an alternating magnetic interrogation field that is disturbed when a target 30 passes through it, indicating an attempted theft of these items occurs.

*Buckens* contains the same deficiency as *Larson* and *Pare*. Namely, it does not disclose the associating of a returned shopping cart with a particular customer. Rather, it only discloses the scanning of shopping cart contents for theft. As such, it does not disclose all elements of the claims as amended.

The Obviousness-type Double Patenting Rejection

As each of *Larson*, *Pare*, or *Buckens* fails to disclose the same limitation, an obviousness-type double patenting objection cannot be made. The analysis employed in an obviousness-type double patenting rejection parallels the analysis in 35 U.S.C. § 103(a) obviousness determinations. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225

Application Serial No. 09/535,076  
Response to First Office Action  
Attorney Docket No. 0103490-165104  
Page 10

USPQ 645 (Fed. Cir. 1985). Because all of the cited references collectively fail to disclose at least one limitation of claims 1-16, the claims are not subject to a § 103(a) rejection and, accordingly, are also not subject to an obviousness-type double patenting rejection.

Application Serial No. 09/535,076  
Response to First Office Action  
Attorney Docket No. 0103490-165104  
Page 11

### CONCLUSION

In view of the above, it is respectfully submitted that Claims 1-16 are allowable.

The Examiner is invited to call Applicant's attorney at the number below in order to speed the prosecution of this application.

The Commissioner is authorized to charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 07-1896.

Respectfully submitted,

GRAY CARY WARE AND FREIDENRICH LLP

Dated: 10/29/04

By 

Jon Y. Ikegami

Reg. No. 51,115

Attorney for Applicant

GRAY CARY WARE AND FREIDENRICH LLP  
2000 University Avenue  
East Palo Alto, CA 94303  
Telephone: (650) 833-2055

PA\10381935.1  
103490-165104